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EXAMINER

O'CONNOR, GERALD J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20061214

Application Number: 09/396,612
Filing Date: September 15, 1999
Appellant(s): Stevens et al.

Jeremy J. Curcuri
(Reg. No. 42,454)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed October 6, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Comcast Cable Holdings, LLC)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-8 and 10 are pending, rejected, and appealed.)

(Claim 9 has been cancelled.)

(Claims 11-23 remain pending, but stand withdrawn.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (An after-final amendment was filed on April 3, 2003, and was entered.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. (US 5,664,110).
- II. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenney (US 6,026,376).
- III. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Petrovich et al. (US 6,101,483).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct. .

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 5,664,110	Green et al.	9/1997
US 6,026,376	Kenney	2/2000
US 6,101,483	Petrovich et al.	8/2000

(9) *Grounds of Rejection*

I. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. (US 5,664,110).

Green et al. disclose a method for automating the management of an inventory of consumer items at a consumer location using a programmed device accepting input data and executing instructions for automating inventory management, the method comprising: receiving a series of shopping lists, each shopping list including at least one item; establishing a shopping list trend based on the series of shopping lists; generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list; receiving a plurality of item price lists from a corresponding plurality of shopping locations; and, recommending a shopping location based on the plurality of item price lists and the output list.

Regarding claim 2, in the method of Green et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; storing information indicative of the shopping list on a data storage medium; and, thereafter, retrieving the information from the data storage medium.

Regarding claim 3, in the method of Green et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; sending information indicative of the shopping list over a network; and, receiving the information from the network.

Regarding claim 4, the method of Green et al. further comprises: receiving at least one consumed item list including at least one item that has been consumed, wherein the shopping list trend is further based on the at least one consumed item list.

Regarding claim 5, in the method of Green et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof, the item having a tag and the item being identified by recognizing the tag.

Regarding claim 6, in the method of Green et al., the tag is a bar code and the tag is recognized by scanning the bar code.

Regarding claim 7, in the method of Green et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof by recognizing the item with a camera.

Regarding claim 8, the method of Green et al. further comprises: comparing the output list with the next shopping list; and, modifying the shopping list trend based on the comparison.

Regarding claim 10, in the method of Green et al., generating the output list further comprises: receiving an item list for a recipe; and, generating the output list further based on the item list for the recipe.

II. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenney (US 6,026,376).

Kenney discloses a method for automating the management of an inventory of consumer items at a consumer location using a programmed device accepting input data and executing instructions for automating inventory management, the method comprising: receiving a series of shopping lists, each shopping list including at least one item; establishing a shopping list trend based on the series of shopping lists; generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list; receiving a plurality of item price lists from a corresponding plurality of shopping locations; and, recommending a shopping location based on the plurality of item price lists and the output list.

Regarding claim 2, in the method of Kenney, receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; storing information indicative of the shopping list on a data storage medium; and, thereafter, retrieving the information from the data storage medium.

Regarding claim 3, in the method of Kenney, receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; sending information indicative of the shopping list over a network; and, receiving the information from the network.

Regarding claim 4, the method of Kenney further comprises: receiving at least one consumed item list including at least one item that has been consumed, wherein the shopping list trend is further based on the at least one consumed item list.

Regarding claim 5, in the method of Kenney, receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof, the item having a tag and the item being identified by recognizing the tag.

Regarding claim 6, in the method of Kenney, the tag is a bar code and the tag is recognized by scanning the bar code.

Regarding claim 7, in the method of Kenney, receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof by recognizing the item with a camera.

Regarding claim 8, the method of Kenney further comprises: comparing the output list with the next shopping list; and, modifying the shopping list trend based on the comparison.

Regarding claim 10, in the method of Kenney, generating the output list further comprises: receiving an item list for a recipe; and, generating the output list further based on the item list for the recipe.

III. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Petrovich et al. (US 6,101,483).

Petrovich et al. disclose a method for automating the management of an inventory of consumer items at a consumer location using a programmed device accepting input data and executing instructions for automating inventory management, the method comprising: receiving a series of shopping lists, each shopping list including at least one item; establishing a shopping list trend based on the series of shopping lists; generating an output list in accordance with the shopping list trend such that the output list is predictive of a next shopping list; receiving a plurality of item price lists from a corresponding plurality of shopping locations; and, recommending a shopping location based on the plurality of item price lists and the output list.

Regarding claim 2, in the method of Petrovich et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; storing information indicative of the shopping list on a data storage medium; and, thereafter, retrieving the information from the data storage medium.

Regarding claim 3, in the method of Petrovich et al., receiving a shopping list of the series of shopping lists further comprises: determining a shopping list of a shopping trip; sending information indicative of the shopping list over a network; and, receiving the information from the network.

Regarding claim 4, the method of Petrovich et al. further comprises: receiving at least one consumed item list including at least one item that has been consumed, wherein the shopping list trend is further based on the at least one consumed item list.

Regarding claim 5, in the method of Petrovich et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof, the item having a tag and the item being identified by recognizing the tag.

Regarding claim 6, in the method of Petrovich et al., the tag is a bar code and the tag is recognized by scanning the bar code.

Regarding claim 7, in the method of Petrovich et al., receiving the at least one consumed item list further comprises: identifying an item upon consumption thereof by recognizing the item with a camera.

Regarding claim 8, the method of Petrovich et al. further comprises: comparing the output list with the next shopping list; and, modifying the shopping list trend based on the comparison.

Regarding claim 10, in the method of Petrovich et al., generating the output list further comprises: receiving an item list for a recipe; and, generating the output list further based on the item list for the recipe.

(10) Response to Argument

I. Claims 1-8 and 10 are unpatentable under 35 U.S.C. 102(b) for being anticipated by Green et al. (US 5,664,110).

Regarding the argument that Green et al. disclose neither “establishing a shopping list trend,” nor “generating an output list in accordance with the shopping list trend,” Green et al. indeed disclose these features. See, in particular, column 3, lines 45-63, and the references therein to items that are “regularly ordered” (lines 54-58), which regularly ordered items a user can conveniently “incorporate into an order list currently being constructed” (lines 52-53).

Regarding the argument that Green et al. fail to disclose certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., performing the method steps in an automated fashion by means of a machine) are not recited in the rejected claim(s). Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case, all of the recited steps/functionality can be performed manually or mentally, without any machine, and the few claim recitations directed to any apparatus at all (i.e., things) utilized in the method steps are so broad as to read on far more than appellant’s *disclosed* invention. For example, “a data storage medium,” as recited in claim 2 (the first recitation of any apparatus in the body of the claims) reads on merely a slip/scrap of paper on which one could “store information” (jot down some notes, such as a grocery list, and

“retrieve information” (read the notes). Other recitations, such as “over a network” in claim 3, may involve apparatus (such as making a phone call over a telephone network), or may not involve apparatus at all (since a network could be a group of people, such as a family, and sending information over the network could be simply a mom telling her son to tell his dad to pick up some milk at the store).

II. Claims 1-8 and 10 are unpatentable under 35 U.S.C. 102(e) for being anticipated by Kenney (US 6,026,376).

Regarding the argument that Kenney does not disclose “the programmed device defined by claim 1,” Kenney indeed discloses the programmed device defined by claim 1, as the system of Kenney indeed includes the use of “a programmed device accepting input data and executing instructions for automating inventory management,” as required by claim 1.

Regarding the argument that Kenney fails to disclose certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., performing the method steps in an automated fashion by means of a machine) are not recited in the rejected claim(s). Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case, all of the recited steps/functionality can be performed manually or mentally, without any machine, and the few claim recitations directed to any apparatus at all

(i.e., things) utilized in the method steps are so broad as to read on far more than appellant's *disclosed* invention. For example, "a data storage medium," as recited in claim 2 (the first recitation of any apparatus in the body of the claims) reads on merely a slip/scrap of paper on which one could "store information" (jot down some notes, such as a grocery list, and "retrieve information" (read the notes). Other recitations, such as "over a network" in claim 3, may involve apparatus (such as making a phone call over a telephone network), or may not involve apparatus at all (since a network could be a group of people, such as a family, and sending information over the network could be simply a mom telling her son to tell his dad to pick up some milk at the store).

III. Claims 1-8 and 10 are unpatentable under 35 U.S.C. 102(e) for being anticipated by Petrovich et al. (US 6,101,483).

Regarding the argument that Petrovich et al. do not disclose "the programmed device defined by claim 1," Petrovich et al. indeed disclose the programmed device defined by claim 1, as the system of Petrovich et al. indeed includes the use of "a programmed device accepting input data and executing instructions for automating inventory management," as required by claim 1.

Regarding the argument that Petrovich et al. fail to disclose certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., performing the method steps in an automated fashion by means of a machine) are not recited in the rejected

claim(s). Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


In this case, all of the recited steps/functionality can be performed manually or mentally, without any machine, and the few claim recitations directed to any apparatus at all (i.e., things) utilized in the method steps are so broad as to read on far more than appellant's *disclosed* invention. For example, "a data storage medium," as recited in claim 2 (the first recitation of any apparatus in the body of the claims) reads on merely a slip/scrap of paper on which one could "store information" (jot down some notes, such as a grocery list, and "retrieve information" (read the notes). Other recitations, such as "over a network" in claim 3, may involve apparatus (such as making a phone call over a telephone network), or may not involve apparatus at all (since a network could be a group of people, such as a family, and sending information over the network could be simply a mom telling her son to tell his dad to pick up some milk at the store).

(11) *Related Proceeding(s) Appendix*

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




12/14/06


Gerald J. O'Connor
Primary Examiner
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GJOC

December 14, 2006

Appeal Conference Held:

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Supervisory Patent Examiner
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Application: 09/396,612

Paper No. 20061214

Art Unit: 3627

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